

### Remarks

Applicants have carefully studied the outstanding Office Action mailed July 15, 2004, and the newly cited art. The present response is intended to be fully responsive to the rejection raised by the Office Action and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

#### **1. Summary of Office Action**

In the Office Action mailed July 15, 2004, the Examiner rejected claims 1-9, 12, 14-31, and 33-38 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,421,707 (Miller). The Examiner rejected claims 10-11 under 35 U.S.C. 103(a) as unpatentable over Miller in view of U.S. Patent 6,333,973 (Smith). And, the Examiner rejected claims 13 and 32 under 35 U.S.C. 103(a) as being unpatentable over Miller in view of U.S. Patent 6,393,014 (Daly).

Although claim 17 is summarily listed as anticipated by Miller, the Examiner did not make any explanation of the rejection or further note the rejection.

The Examiner allowed claim 39. Pending in this application are claims 1-37 and 39-46. Of those, claims 1, 18, 19, 21, 39 and 40 are independent. The rest are dependent.

#### **2. Amendments**

Independent claims 1, 18, 19 and 21 have been amended to add limitations that track the Examiner's reasons for allowance of claim 39. For instance, claim 1 has been amended to include maintaining a registration record an instant messaging (IM) network server indicating that a second station is available to receive messages, but pointing to an IM client proxy address as an address to which messages destined for the second station should be sent. Claims 18, 19, 21, and newly added claim 40 reflect parallel limitations.

In addition, Applicants have amended claim 1 and its dependents by replacing the term "machine" with "IM client proxy" in order to more particularly specify embodiments of the invention. This amendment is made for clarity rather than patentability.

In claim 2, the function of storing a correlation between the return ID and the second station was amended to show that the function is done in response to the first message. Claim 5 is amended to change its dependency. It now depends from claim 2. Claim 19 is amended to clarify that the spoken message is a spoken response message. Some typographical corrections were made to independent claim 21 and dependent claim 28 to put the claims in better form for allowance.

Claim 38 was cancelled. Independent claim 40 and dependent claims 41-46 are new.

Pending in this application are claims 1-37 and 39-46. Of those, claims 1, 18, 19, 21, 39 and 40 are independent. The rest are dependent.

### **3. Claimed Invention**

In the summary of the invention, Applicants disclose a robust instant messaging (IM) system that includes three basic properties: (i) the ability to receive instant messages at an IM client; (ii) the ability to respond to an instant message; and (iii) a mechanism for keeping the IM system apprised of whether the IM client is available to receive instant messages. These three elements are known as the *receive*, *respond* and *status* functions.

Speaking generally, Applicants' claimed invention follows the receive, respond and status model by establishing a novel instant messaging system and method that facilitates a) IM communications with a sender and a second station, such as a mobile station; b) delivery of spoken response messages from the mobile station to the sender; and c) the maintenance of

records on an IM server of whether the mobile station is available to receive messages and of records of an IM client proxy address where messages for the mobile station should be directed.

Each of the independent claims provide in some form an IM network server maintaining a registration record indicating when the second station is available to receive messages, but pointing to an IM client proxy address as the address to which messages destined to the second station should be sent. In operation, the IM client proxy receives a first message that is provided by the first station that is destined for the second station. The proxy then sends a version of the first message to the second station (mobile phone). The proxy receives a spoken response message (such as a WAV file) from the second station and sends the spoken response message to the first station.

Claims 7, 21, and 43 further provide for a callback number pointing to a port at the IM client proxy. In the embodiments covered by these claims, the spoken response message is received by the proxy via a call to the callback number. Claims 19, 28, 30 and 40 also include a similar call limitation.

Claim 17 includes the further limitation of receiving an indication of a location of the mobile station so that the spoken response message can be presented together with the location information.

#### 4. Examiner's Reasons for Allowance of Claim 39

In the Office Action, the Examiner allowed claim 39 based on the realization that the prior art references do not disclose a wireless IM system where a) an IM client proxy defines an IM client proxy address; b) an IM server maintains registration records indicating that a mobile station is available to receive messages but pointing to the IM client proxy address as an address to which messages destined for the mobile station should be sent; c) the IM proxy receives a

message from a sender and sends the message to the mobile station; and d) the IM proxy receives a spoken response message from the mobile station and sends the spoken response message to the sender.

### 5. Response to the Rejections

Applicants have amended the claims so that each independent claim now includes, in some form, the limitations given in the Examiner's reasons for allowance of claim 39.

The Examiner rejected each independent claim as being anticipated by Miller. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants respectfully traverse this rejection as moot, since Applicants have amended the independent claims (claims 1, 18, 19, 21, and 40) to include further limitations not even suggested by Miller.

As noted by the Examiner, Miller fails to teach the claimed functions of a) an IM Server maintaining registration records indicating that a second machine (mobile station) is available to receive messages but pointing to an IM client proxy address; b) the IM client proxy receiving a message from a first machine and sending the message to the second machine; c) the IM client proxy receiving and sending a spoken response message from the second machine.

Miller discloses sending a message through a network sever to a mobile station and the option of sending a message using a VOICE delivery format. However, Miller does not disclose any of the claimed functionality associated with the IM client proxy or provide any *status information* indicating whether the mobile station is available to receive messages.

Further, Claims 7, 19, 21, 28, 30, 40, and 43 provide for the spoken response message to be received at the IM client proxy through a call from the mobile station. Of these, claims 7, 21, and 43 further provide for a callback number included in the first message sent to the mobile

station. These elements provide unique functionality and are not disclosed by Miller. The only indication that Miller provides a voice response is in element 412 of Figure 6(i). Figure 6(i) appears to disclose that a user can select VOICE as a delivery format for a message sent from the Mobile Station. However, Miller provides no description of this functionality nor any example of how a voice message may be sent. Simply speaking, Miller's one word disclosure – VOICE – does not anticipate the IM client proxy receiving a spoken response message via the call to the callback number.

Claim 17 provides for receiving an indication of a location of the mobile station so that the spoken response message can be presented together with location information. Miller does not provide any location information. Although the Examiner listed claim 17 as rejected by Miller, the Examiner did not include any reasons for the rejection. Thus, Applications believe that this rejection may have been in error.

## 6. Conclusion

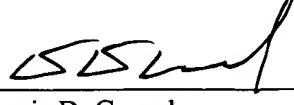
In view of the foregoing, Applicants submit that claims 1-37 and 39-46 are in condition for allowance, and Applicants therefore respectfully request favorable reconsideration.

Respectfully submitted,

**McDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP**

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By:

  
Dennis D. Crouch  
Reg. No. 55,091